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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,191	03/16/2001	Yevgeniy Eugene Shteyn	US 018031	6676

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,191

Applicant(s)

SHTEYN, YEVGENIY EUGENE

Examiner

Siegfried E. Chencinski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/16/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/03/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1-7 are rejected** because the claimed invention is directed to non-statutory subject matter because it is not in the technological arts. Re. Claims 1-5, the word "enabling" limits the claim to merely a potential for electronic notification. Re. Claims 6 and 7, a vehicle and a building are not in the technological arts.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 10 is rejected** under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what constitutes a wireless communications device in this claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-5, 8 and 10 are rejected** under 35 U.S.C. 102(b) as being anticipated by Joao et al. (US Patent 5,878,337, hereafter Joao).

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Re. Claim 1, Joao anticipates a method of providing a notification service to a legitimate user regarding use of an object of the user, the method comprising enabling to communicate an electronic notification to a personal communication device of the user upon detection of the use of the object (Abstract; Col. 1, ll. 8-16; Col. 3, l. 62 – Col. 4, l. 24; Col. 5, ll. 20-25; Col. 5, l. 58 – Col. 6, l. 18).

Re. Claim 2, Joao anticipates a method comprising enabling a party other than the user to be registered as a recipient of the notification (Col. 6, ll. 11-18).

Re. Claim 3, Joao anticipates a method comprising enabling the user to specify a modality of the notification (Col. 6, ll. 11-18).

Re. Claim 4, Joao anticipates a method comprising enabling the user to electronically validate or invalidate the use of the object upon receipt of the electronic notification (Col. 6, ll. 44-49).

Re. Claim 5, Joao anticipates a method wherein the object comprises a credit card (Col. 3, l. 66).

Re. Claim 8, Joao anticipates a method wherein the communication device comprises a mobile phone (Col. 4, l. 2; Col. 6, l. 15).

Re. Claim 10, Joao anticipates a personal communication device for wireless communication of a predefined message to a server upon receipt of an alert and upon a user initiating the communication (Col. 3, l. 62 – Col. 4, Col. 3, ll. 32-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness s rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being disclosed by Joao.

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Re. Claim 6, Joao does not explicitly disclose a method wherein the object comprises a vehicle. However, the ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to include notification of the use of a vehicle to a personal communication device of the user upon detection of the use of the vehicle. The motivation would have been to provide prompt notification to the vehicle owner, lessor, lessee or operator when his or her vehicle is, or has been, utilized in an unauthorized manner (Joao, Col. 3, ll. 54-59).

Re. Claim 7, Joao does not explicitly disclose a method wherein the object is a functional part of a building. However, the ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to include notification of the use of a functional part of a building to a personal communication device of the user upon detection of the use of a functional part of a building. The motivation would have been to provide prompt notification to the building's owner, lessor, lessee or operator when his or her part of a building is, or has been, utilized in an unauthorized manner (Joao, Col. 3, ll. 54-59).

Re. Claim 9, Joao does not explicitly disclose a method of providing a deterrent to unauthorized use of objects of authorized users, the method comprising advertizing that use of at least one of the objects initiates a sending of an electronic notification to a personal communication device of a relevant one of the authorized uses. However, the advertising of security devices and systems has been very visibly in public places, outside of homes and on vehicles for decades or longer, such as the signs which ADT provides to its customers to post on the exterior of windows, doors and walls to advertise the operation of a security system at that location. Therefore, it would have been obvious for the ordinary practitioner of the art at the time of Applicant's invention to have advertised the fact that of the use of at least one of the objects initiates a sending of an electronic notification to a personal communication device of a relevant one of the authorized uses. The motivation have been to deter unauthorized use of a personal communications device (Joao, Col. 3, ll. 54-59).

Conclusion

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4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Souh, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or faxed to:


(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

April 18, 2005


HYUNG SOUH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3628